

REMARKS

Claims 1-78 are pending in the application.

Claims 1-78 have been rejected.

Claims 1, 4-16, 21, 24-36, 41-47, 49-52, 54, 59, and 62-74 have been amended.

Unless otherwise specified in the below discussion, Applicants have amended the above-referenced claims in order to provide clarity or to correct informalities in the claims. Applicants further submit that, unless discussed below, these amendments are not intended to narrow the scope of the claims. By these amendments, Applicants do not concede that the cited art is prior to any invention now or previously claimed. Applicants further reserve the right to pursue the original versions of the claims in the future, for example, in a continuing application.

Rejection of Claims Under 35 U.S.C. §103

Claims 1-14, 17, 18, 20-34, 37-38, 40-47, 49-51, 53-55, 57-72, 75-76, and 78 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,513,152 issued to Branson et al. ("Branson") in view of U.S. Patent 6,300,948 issued to Geller et al. ("Geller"). Applicants respectfully traverse this rejection.

In order for a claim to be rendered invalid under 35 U.S.C. §103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. §103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation

of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Claims 1, 21, 41 and 49: Independent Claims 1, 21, 41 and 59 each contain a limitation of substantially the following form:

generating a customizable product configurator, said generating comprising...

mapping a customizable UI to the customizable product class, wherein the customizable UI provides an access structure to the configurator.

See, e.g., Claim 1 (as amended). Applicants respectfully submit that neither Branson nor Geller, alone or in combination, provides disclosure of these claim limitations. Therefore, Brandon and Geller cannot be said to render the claimed invention obvious.

The Application discloses that the claimed “customizable product configurator” is “a software tool developed by the product or service provider, that allows customers to find the products that suit their unique requirements.” Application, ¶[0005]. As purported disclosure of the “configurator” claim limitation, the Office Action cites to a section of Branson that provides “an infrastructure that embodies the steps necessary to customize a selected object oriented framework.” *See* Office Action, p. 3 (citing Branson 2:25-30). Applicants respectfully submit that the cited section of Branson provides no disclosure of allowing customers to find products, as provided by the Application’s definition of “configurator.” The Application further provides that “configurators are integrated with a set of business rules that help guide the customer as would a sales professional.” Office Action, ¶[0005]. Applicants further note that the cited section of Branson provides no disclosure of such a set of business rules. The cited disclosure of Branson purportedly provides “steps necessary to customize a selected object oriented framework,” which is not the same as the set of rules that generate a customer

environment for configuring a product. Thus, Applicants submit that the cited sections of Branson fail to provide any disclosure of a “customizable product configurator,” as provided in the amended claims.

Moreover, the Office Action admits that Branson fails to provide disclosure of the claimed “mapping a customizable UI to the customizable product class,” a proposition with which Applicants agree. The Office Action then refers to Geller as providing the needed disclosure, but Applicants respectfully submit that the cited sections of Geller do not provide for the claimed “mapping a customizable UI to the customizable product class.”

Geller Figure 3, cited by the Office Action, provides purported disclosure of “the architecture of the preferred configuration program module 10 and its relationship to other data of the enterprise.” Geller 9:41-44. The figure provides no explicit disclosure of the claimed “mapping” nor does the Office Action provide any discussion of how Figure 3 provides disclosure of such “mapping.”

The Office Action then provides cites to the following section of text in Geller:

The present invention therefore provides at least two significant improvements in configurator computer program construction. First, the invention provides a “configurator developer environment” for a sales engineer--who is not necessarily a computer programmer--to create a customized user interface for the configurator program.

See Office Action, p. 4 (citing Geller 10-14). Applicants respectfully submit that the cited section of text provides no disclosure of the claimed “mapping.” Instead, the cited paragraph from the Summary of the Invention section merely states that a so-called “configurator developer environment” is provided with no additional explanation related to that environment.

The Office Action also cites to the following section of text as purported disclosure of the claimed “mapping”:

A user interface creation tool 41 allows a developer to create form or template for a user interface GUI screen, place and modify user controls.

See Office Action, p. 4 (citing Geller 12:60-62). Again, Applicants respectfully submit that the cited section of text provides no disclosure of the claimed “mapping.” But instead, the cited section merely states that the invention purportedly provides a “user interface creation tool” that purportedly allows for the creation of a user interface GUI screen as well as moving controls around on that screen. Thus, Applicants respectfully submit that neither Branson (which is admitted in the Office Action to not provide disclosure of the claimed “mapping”) nor Geller (as demonstrated above) provides disclosure of the claimed “mapping a customizable UI to the customizable product class.”

For at least these reasons, Applicants respectfully submit that the Office Action does not establish the presence of the above-discussed limitations in independent Claims 1, 21, 41 and 59, and all claims depending therefrom, in Branson or Geller, alone or in combination. The burden is on the Examiner to support a case of obviousness, including whether the prior art references teach or suggest all of the claim limitations. *See* MPEP 706.02(j).

Claims 14, 34, 46 and 72: Dependent Claims 14, 34, 46 and 72, as amended each contain a limitation of substantially the following form: “wherein the customizable UI is a subclass of the customizable product class.” *See, e.g.*, Claim 14 (as amended). Applicants respectfully submit that neither Branson nor Geller, alone or in combination, disclose this claim limitation.

In rejecting these claims, the Office Action merely refers back to the rejection provided for independent Claim 1. *See* Office Action, p. 7. As an initial matter, Applicants have already provided discussion establishing that neither of the references provides disclosure of all of the limitations of independent Claim 1.

In addition, the language of Claims 14, 34, 46 and 72 et al. provides that the claimed “customizable UI” is a subclass of the claimed “customizable product class.” The Office Action admits that Branson fails to teach a customizable UI. Therefore, Branson cannot supply disclosure purportedly providing a customizable UI that is a subclass of the customizable product class. Geller provides disclosure of a separate environment for the generation of a user interface and, therefore, provides no disclosure of the claim limitation. Geller Figure 3 illustrates three separate environments: a user environment (10), an enterprise data environment (21), and a configuration designer developer environment (18). There is no indication in Geller Figure 3 that a user interface developed in designer environment 18 is intended to be a subclass of a customizable product class (especially since Geller fails to provide disclosure of a customizable product class and the Office Action makes no argument that Geller does so provide such a customizable product class). Geller further provides that the user environment 10 is a “standalone configuration program module 10 including a user interface component 32 and a configuration logic component 34.” Geller 13:8-11. Geller also provides that the “output of the developer environment 18 is the compiled configuration program module 10.” Geller 16:6-11. Applicants respectfully submit that Geller provides no provision for storing elements of the user interface purportedly generated by developer environment 18 as a subclass of the customizable product class, as claimed.

For at least these reasons, and those discussed above, Applicants respectfully submit that the Office Action does not establish the presence of the limitations found in Claims 14, 37, 46 and 72, as amended, and all claims depending therefrom, in Branson or Geller, alone or in combination.

In addition, Applicants also respectfully submit that the Office Action does not satisfy the burden of factually supporting the alleged motivation to combine the two references. This duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Office Action must therefore provide evidence to suggest the combination and “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Further, the Office Action does not establish that such a combination of the teachings of these references would meet with success, as required.

Applicants respectfully submit that combining Geller with Branson is merely duplicative at least of the disclosure found in Geller. As illustrated in Geller Figure 3, Geller already discloses the presence of a purported data store (element 21). Thus, there would be no need to combine Geller with another reference that purportedly provides a data store, such as Branson.

The stated purpose of Branson is to provide a “framework customization framework mechanism for customizing an input framework and for generating from the input framework a customized framework.” Branson 14:66-15:2. The disclosed “framework customization framework mechanism” of Branson purportedly “provides an architecture for customizing any input framework using a common interface and set of tools.” Branson 16:50-53. a stated purpose of Branson is to provide “a substantially

common user interface for customizing any input framework.” Branson 2:43-44. Thus, Applicants respectfully submit that providing a mechanism for generating a customizable user interface such as that purportedly disclosed by Geller is contrary to the stated purpose of Branson. Therefore, a person of ordinary skill would not be motivated to combine the two references and, in fact, would be taught away from providing such a combination.

Applicants respectfully submit that the argument provided in the Office Action fails to establish a *prima facie* case of obviousness and runs perilously close to a forbidden hindsight analysis of the references. The Office Action makes no showing of a motivation to combine Branson with Geller from within the references themselves; therefore, it must be presumed that there is none. It is well-established that the best defense to hindsight is a “rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. *See Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000).; *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000). A showing of combinability must be “clear and particular” and “broad conclusive statements about the teaching of multiple references, standing alone, are not ‘evidence’”. *See Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666 (Fed. Cir. 2000); *Brown & Williamson*, 229 F.3d at 1125.

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.”

Ruiz, 234 F.3d at 665.

The Office Action presents nothing more than broad, generalize statements relating to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. The Office Action does not establish that the references which were combined are of special interest or importance in the field. Nor does the Office Action present any evidence of a problem to be solved from within those references themselves. Instead, the Office Action fabricates such a problem to be solved, not from the teachings of the cited references, but from the teaching of Applicants' own disclosure. Using Applicants' own disclosure as a blueprint for providing the motivation to combine prior art references in a obviousness determination is impermissible. *See W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552-1553. (Fed. Cir. 1983).

Applicants further submit that there is no indication from within the references that combining Branson with Geller would meet with success, as required. Geller, as discussed above, discloses a data store (21). Geller provides no disclosure that the data stored in that data store is in the form of object classes. Instead, Geller refers to that data as a "database." *See, e.g., Branson* 8:29-31. There is no indication that Geller could function with object class information in the form of a datastore, nor is there any reason for one of skill in the art to suppose such an arrangement would provide any advantage over Geller's use of a "database." As already discussed above, Branson itself teaches away from the use of a customizable user interface such as that provided in Geller. Applicants respectfully submit that Branson would, therefore, not function with the use of a customizable user interface as Branson discloses a desire to have a common user interface. Further, there is no indication that a combination of Branson with Geller would successfully provide the claimed invention, especially since, as discussed above, there is

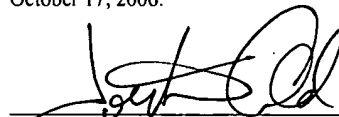
no indication of providing the claimed “mapping a customizable user interface to the customizable product class” in either reference.

For at least these reasons, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness of independent Claims 1, 21, 41 and 59, and all claims depending therefrom, and Claims 14, 37, 46 and 72, and that they are in condition for allowance. Applicants therefore respectfully request the Examiner’s reconsideration and withdrawal of the rejections to those claims and an indication of the allowability of same.

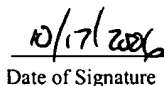
CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

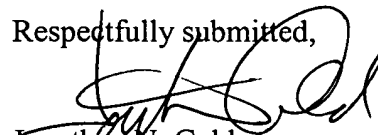
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Attorney for Applicant(s)


Date of Signature

Respectfully submitted,


Jonathan N. Geld
Attorney for Applicants
Reg. No. 44,702
(512) 439-5090 [Phone]
(512) 439-5099 [Fax]